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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 47

Application Number: 08/738,659

Filing Date: 10/30/96

Appellant(s): Motoyama

James J. Kulbaski

For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 08/29/2001.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments*

The appellant's statement of the status of amendments contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims of the following groups of claims stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Group I: Claims 10, 16, 36, and 42, and all depending claims.

Group II: Claims 18 and 44.

Group III: Claims 72-87.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix A to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

Kraslavsky et al	5,537,626	07-1996
Cohn et al	5,740,231	04-1998

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 10, 12-19, 36, 38-44, 52-61, and 68-87 are presented for examination.
2. The following is a quotation of 35 U.S.C. § 103 (a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 10, 12-19, 36, 38-44, 52-61, and 68-87 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over **Kraslavsky et al (Kraslavsky)** patent no. **5,537,626**, in view of **Cohn et al (Cohn)** patent no. **5,740,231**.

4. As to claims 10 and 68, **Kraslavsky** teaches the invention substantially as claimed, including a method for communicating between a monitored device (**Kraslavsky**, printer 4, figure 1) and a monitoring device (**Kraslavsky**, NTWK ADMIN PC 14, figure 1) comprising the steps of:

determining information to be transmitted by the monitoring device to the monitored device, the information including a request for a status of the monitored device determined using sensors within the monitored device (**Kraslavsky**, col. 39 lines 9-20, and Table 10 begins on col. 41 line 35. In addition, **Kraslavsky** inherently teaches the information of the printer is obtained from sensors as clearly described by **Banno et al** patent no. **4,876,606** dated **10/24/89** col. 3 line 66 - col. 4 line 11); and

transmitting the information as a message from the monitoring device to the monitored device through one or more LANs in Wide Area Network (**Kraslavsky**, col. 7 lines 38-63).

However, **Kraslavsky** does not explicitly teach the message is being transmitted as an Internet electronic mail message.

Cohn teaches various source and destination message systems that comprise voice mail, electronic mail, facsimile transmission, video transmission facilities, other data transmission or receipt facilities that can communicate message to each others using Internet electronic mail message format (**Cohn**, col. 8 lines 36-65, and col. 15 line 65 - col. 16 line 36; Examiner consider various source and destination message systems taught by **Cohn** are business office devices). Furthermore, **Kraslavsky** teaches using TCP/IP standard protocol that fully supports Internet electronic mail (**Kraslavsky**, col. 29 lines 35-46).

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of **Kraslavsky** and **Cohn** to use Internet electronic mail message format to communicate (transmit and receive) between **Kraslavsky's** monitored and monitoring devices because it would allow the message to be transferred globally between any devices (devices that are taught in **Kraslavsky** and **Cohn's** references).

5. As to claims 12-13, **Kraslavsky** teaches transmitting the information to the monitored device which is a business office device such as copier, facsimile machine, or printer (**Kraslavsky**, Abstract, and col. 2 lines 35-62).

6. As to claim 14, **Kraslavsky** and **Cohn** teach receiving the transmitted information by the monitored device; and transmitting, through the Internet, an Internet electronic mail message from the monitored device to the monitoring device containing status information of the monitored device, in response to the transmitted information from the monitoring device (**Kraslavsky**, col. 2 lines 35-62, col. 4 lines 3-14, col. 7 lines 38-63; **Cohn**, col. 8 lines 36-65, and col. 15 line 65 - col. 16 line 36).

7. As to claim 15, **Kraslavsky** teaches transmitting the information from the monitoring device to a plurality of monitored devices including the monitored device (**Kraslavsky**, col. 34 lines 63-67).

8. As to claims 52-53, **Cohn** inherently teaches Internet electronic mail message includes an "@" symbol followed by a domain name, and a description of an encoding type of the Internet electronic mail message. This information is also admitted by applicant as well known.

9. As to claim 54, **Kraslavsky** and **Cohn** teach the invention substantially as claimed as discussed above; however, they do not explicitly teach using a firewall. Official Notice is taken that firewall is well known in Data Processing Art. It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to use a firewall in **Kraslavsky** and **Cohn**'s network because it would not allow communication between the monitor device and the machine if message do not satisfy filter conditions in the firewall.

10. As to claims 55-56, they have similar limitations as claims 52-53; therefore, they are rejected under the same rationale as discussed above.

11. As to claims 72-73, **Kraslavsky** and **Cohn** teaches transmitting the Internet electronic mail message through a Local Area Network without using a telephone line (**Kraslavsky**, col. 2 lines 35-58; **Cohn**, col. 8 lines 36-65, and col. 15 line 65 - col. 16 line 36).

12. As to claims 74-75, they have similar limitations as claims 72-73; therefore, they are rejected under the same rationale as discussed above.

13. As to claims 16 and 69, **Kraslavsky** teaches the invention substantially as claimed, including a method for communicating between a machine and a monitoring device, comprising the steps of:

determining status information using at least one of a mechanical and electrical sensor (**Kraslavsky**, col. 39 lines 9-20, and Table 10 begins on col. 41 line 35, **Kraslavsky** inherently teaches the information of the printer is obtained from sensors as clearly described by **Banno et al** patent no. **4,876,606** dated **10/24/89** col. 3 line 66 - col. 4 line 11); and

transmitting the status information from the machine to the monitoring device through one or more LANs in Wide Area Network (**Kraslavsky**, col. 7 lines 38-63).

However, **Kraslavsky** does not explicitly teach the message is being transmitted as an

Internet electronic mail message.

Cohn teaches various source and destination message systems that comprise voice mail, electronic mail, facsimile transmission, video transmission facilities, other data transmission or receipt facilities that can communicate message to each others using Internet electronic mail message format (**Cohn**, col. 8 lines 36-65, and col. 15 line 65 - col. 16 line 36). Furthermore, **Kraslavsky** teaches using TCP/IP standard protocol that fully supports Internet electronic mail (**Kraslavsky**, col. 29 lines 35-46).

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of **Kraslavsky** and **Cohn** to use Internet electronic mail message format to communicate (transmit and receive) between **Kraslavsky's** machine and monitoring device because it would allow message to be transferred globally between any machine and device.

14. As to claim 17, **Kraslavsky** and **Cohn** teach analyzing the status information by the machine, wherein the status information is transmitted as the Internet electronic mail message from the machine when the status information is analyzed and determined to be within a standard operating range (**Kraslavsky**, col. 39 lines 20-54; **Cohn**, col. 8 lines 36-65, and col. 15 line 65 - col. 16 line 36).

15. As to claim 18, **Kraslavsky** and **Cohn** teach determining status information which is outside of normal operating parameters exists in the machine using at least one of the mechanical

and electrical sensor; and transmitting a connection-mode message from the machine to the monitoring device containing the status information which is outside of the normal operating parameters (**Kraslavsky**, col. 39 lines 20-54; **Cohn**, col. 8 lines 36-65, and col. 15 line 65 - col. 16 line 36, **Kraslavsky** inherently teaches the information of the printer is obtained from sensors as clearly described by **Banno et al** patent no. **4,876,606** dated **10/24/89** col. 3 line 66 - col. 4 line 11).

16. Claims 19, 36, 38-44, 57-61, 69-71, and 76-87 have similar limitations as claims 10, 12-18, 52-56, and 72-75; therefore, they are rejected under the same rationale as discussed above.

17. In the remarks, applicant argued in substance that

(A) Nothing has been able to persuade Examiner that there is any allowable subject matter in this application.

As to point (A), applicant is totally wrong. Examiner issued patent no. 5,819,110 which is a parent application of this application. In addition, in May 2001, Examiner drafted and communicated informally using fax a proposed an independent claim 10 that could be allowed over the prior art applied by Examiner for this application. However, applicant did not accept the proposal, and applicant only insisted on getting patent for broader claims which considered unpatentable over **kraslavsky and Cohn** by Examiner.

The proposed independent claim 10 mentioned above is described below:

Claim 10. A method for using Internet electronic mail message to manage business

device automatically without human intervention, comprising the steps of:

monitoring an business device by an business device server;

generating a first Internet electronic mail by the business device server and transmit to the business device, the first Internet electronic mail includes a request for a status of the business device determined using sensors within the business device;

generating a second Internet electronic mail to report current status by the business device and transmit to the business device server in response to the status request of the first Internet electronic mail when the business device is in normal operating condition; and

wherein the business device comprises at least a printer, copier, or a facsimile machine.

(B) Examiner provide the same old rejection.

As to point (B), a good and solid Office Action is always a good and solid Office Action from the beginning.

(C) There is no explanation as how **Banno** can be combined with **Kraslavsky** and **Cohn** nor any motivation provided relating to such a combination.

As to point (C), **Banno** reference is used by Examiner to show inherently teachings of **Kraslavsky** as clearly stated in the Office Action. Therefore, no motivation is necessary.

(D) Applicant provides various rationales derive from an opinion of a single individual to show Kraslavsky and Cohn might not be combined together. Those rationales are:

- (D-1) Email is too slow and not interactive enough to be utilized in the system of Kraslavsky.
- (D-2) Cohn teaches the use of Internet Email format when there is a problem with diverse communication protocols and formats: Kraslavsky does not use diverse protocols and formats.
- (D-3) The examiner's rationale for modifying Kraslavsky to allow the global transfer of message is insufficient.
- (D-4) It is not clear from the Office Action how the combine system of Kraslavsky and Cohn would operate.

As to point (D-1), Applicant has provided unproven rationales that have no support from Kraslavsky nor Cohn. Examiner can not find anywhere in Kraslavsky that explicitly describes that email is too slow and not interactive enough to be utilized in Kraslavsky's system as argued by applicant. Again, Examiner can not find anywhere in either Kraslavsky nor Cohn that explicitly describes that Internet email format does not work in Kraslavsky's system as argued by applicant.

On the contrary to a applicant's argument that email is too slow, Kraslavsky's invention is to eliminate the necessity of dedicating a personal computer to manage a peripheral such as a printer by providing an apparatus for interfacing the printer to a LAN to make the printer intelligent (Kraslavsky, Field of the Invention, col. 1 lines 14-23). Obviously, Kraslavsky does not teach improving system speed by connecting the printer on LAN because a computer has a

printer connected directly on the computer's parallel port provides the best real-time or near real time for status information compare to printer connected on LAN. In addition, **Kraslavsky** teaches using TCP/IP standard protocol that fully supports Internet electronic mail (**Kraslavsky**, col. 29 lines 35-46). Therefore, combining **Cohn's** teaching to use Internet electronic mail to manage **Kraslavsky's** peripheral enhances **Kraslavsky's** invention.

As to point (D-2), applicant argued in this paper that **Kraslavsky** does not use diverse protocols and formats. However, applicant admitted (page 9 of paper number 16 filed on 02/17/1998) that "Kraslavsky et al. Include the use of many different protocols including TCP/IP which already allows for global transfer between devices" (**Kraslavsky**, col. 18 line 60 - col. 19 line 4). TCP/IP supports multimedia data. Applicant should review chapter 25 of the book that specifically teaches Electronic Mail in TCP/IP cited by Examiner in paper 20 (Appendix A, Commer, section 25.6 TCP/IP Standards For Electronic Mail Service begins on page 438, and section 25.9 Simple Mail Transfer Protocol (SMTP) begins on page 440). It is well known by one of ordinary skill in the art at the time the invention was made that Internet electronic mail is TCP/IP standard for electronic mail service and this well known feature is clearly documented by Douglas E. Commer's book titled "Internetworking With TCP/IP".

As to point (D-3), In rejecting applicant invention, Examiner stated that **Kraslavsky** teaches the invention substantially as claimed, including a method for communicating between a monitored device (**Kraslavsky**, printer 4, figure 1) and a monitoring device (**Kraslavsky**, NTWK

ADMIN PC 14, figure 1) comprising the steps of:

determining information to be transmitted by the monitoring device to the monitored device, the information including a request for a status of the monitored device determined using sensors within the monitored device (**Kraslavsky**, col. 39 lines 9-20, and Table 10 begins on col. 41 line 35. In addition, **Kraslavsky** inherently teaches the information of the printer is obtained from sensors as clearly described by **Banno et al** patent no. **4,876,606** dated **10/24/89** col. 3 line 66 - col. 4 line 11); and

transmitting the information as a message from the monitoring device to the monitored device through one or more LANs in Wide Area Network (**Kraslavsky**, col. 7 lines 38-63).

However, **Kraslavsky** does not explicitly teach the message is being transmitted as an Internet electronic mail message.

Cohn teaches various source and destination message systems that comprise voice mail, electronic mail, facsimile transmission, video transmission facilities, other data transmission or receipt facilities that can communicate message to each others using Internet electronic mail message format (**Cohn**, col. 8 lines 36-65, and col. 15 line 65 - col. 16 line 36; Examiner consider various source and destination message systems taught by **Cohn** are business office devices). Furthermore, **Kraslavsky** teaches using TCP/IP standard protocol that fully supports Internet electronic mail (**Kraslavsky**, col. 29 lines 35-46).

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of **Kraslavsky** and **Cohn** to use Internet electronic mail message format to communicate (transmit and receive) between **Kraslavsky's** monitored and

monitoring devices because it would allow the message to be transferred globally between any devices (devices that are taught in **Kraslavsky** and **Cohn's** references).

Examiner believe that the motivation was given above to combine **Kraslavsky** and **Cohn** is sufficient. In addition, Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, **Kraslavsky** teaches using TCP/IP standard protocol that fully supports Internet electronic mail in communicating between the monitoring and monitored devices (**Kraslavsky**, col. 29 lines 35-46), and **Cohn** clearly teaches using Internet electronic mails to communicate globally between various source and destination message systems that comprise voice mail, electronic mail, facsimile transmission, video transmission facilities (**Cohn**, col. 8 lines 36-65, and col. 15 line 65 - col. 16 line 36; Examiner consider various source and destination message systems taught by **Cohn** are business office devices).

Moreover, the test for obviousness is not whether the features of one reference may be bodily incorporated into the other reference to produce the claimed subject matter but simply what the references make obvious to one of ordinary skill in the art.

"(T)he proper inquiry should not be limited to the specific structure shown by the references, but should be into the concepts fairly contained therein, and the overriding question to be determined is whether those concepts would suggest one skilled in the art the modification called for by the claims", *In re Bascom*, 109 USPQ 98, 100 (CCPA 1956). "What appellants overlook is that it is not necessary that the inventions of the references be physically combinable

to render obvious the invention under review." In re Sneed, 218 USPQ 385, 389 (CAFC 1983). "The argument that one cannot bodily incorporate the two set of references because in one the speed of the air-fuel mixture is allegedly subsonic, whereas in the other it is sonic, is irrelevant. The test for obviousness is not whether the features of one reference may be bodily incorporated into another reference. Rather, we look to see whether the combined teachings render the claimed subject matter obvious", In re Wood and Eversole, 202 USPQ, 171, 174 (CCPA, 1979).

As to point (D-4), Examiner has discussed in (D-3) that the combination of the teachings of **Kraslavsky** and **Cohn** results in using Internet electronic mail message format to communicate status between **Kraslavsky's** monitored and monitoring device.

(E) Applicant argued that the prior art does not teach "using Internet electronic mail when information which has been analyzed is within a standard operating range, and using a connection-mode message when the status information is outside of the normal operating parameters" as claimed in claims 18 and 44.

As to point (E), As point out by Examiner in paper 20, it is well known that the Internet provides both connection and connectionless mode of communication. Internet electronic mail message is supported by SMTP protocol using TCP connection protocol which is connection mode of communication as described in SMTP Simple Mail Transfer Protocol by Stevens' reference which was submitted by applicant (Appendix B, Stevens, SMTP: Simple Mail Transfer Protocol pages 441-444). Connectionless mode of communication is well known that it does not provide return messages or acknowledgments. Internet electronic mail supported by SMTP protocol using TCP connection protocol provides acknowledgments and it clearly described by Stevens. In addition, **Kraslavsky** teaches a peripheral such as a printer device has 29 possible status conditions

including within a standard operating range such as NORMAL, and outside of normal operating parameters such as OFFLINE, LINEERROR22, etc, and the printer can determine its own condition or status (col. 39 lines 20-54). Therefore, the combination of **Kraslavsky and Cohn's** teaching results in transmitting Internet electronic mail message which is a connection mode message from the monitored device that has status condition that is within a standard operating range, and also for status conditions that is outside of normal operating parameters.

(F) Long-felt but unresolved need.

As to point **(F)**, Examiner disagree because electronic mail and Internet electronic mails have been used long before applicant's invention. Furthermore, **Cohn** filed a patent application in September 1994 to teach various source and destination message systems that comprise voice mail, electronic mail, facsimile transmission, video transmission facilities, other data transmission or receipt facilities that can communicate message to each others using Internet electronic mail message format (**Cohn**, col. 8 lines 36-65, and col. 15 line 65 - col. 16 line 36; Examiner consider various source and destination message systems taught by **Cohn** are business office devices). Any electronic mail message has at least control information that is being used by source and destination message systems. Moreover, **Kraslavsky** filed a patent application on November 1992 to teach using TCP/IP standard protocol that fully supports Internet electronic mail (**Kraslavsky**, col. 29 lines 35-46).

Examiner has considered all of applicant's argument.

The ultimate determination of patentability must be based on consideration of the entire record, by a preponderance of evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence. In *re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The submission of objective evidence of patentability does not mandate a conclusion of patentability in and of itself. In *re Chupp*, 816 F.2d 643, 2 USPQ2d 1437 (Fed. Cir. 1987). Facts established by rebuttal evidence must be evaluated along with the facts on which the conclusion of a prima facie case was reached, not against the conclusion itself. In *re Eli Lilly*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990). In other words, each piece of rebuttal evidence should not be evaluated for its ability to knockdown the prima facie case. All of the competent rebuttal evidence taken as a whole should be weighed against the evidence supporting the prima facie case. In *re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). Although the record may establish evidence of secondary considerations which are indicia of nonobviousness, the record may also establish such a strong case of obviousness that the objective evidence of nonobviousness is not sufficient to outweigh the evidence of obviousness. *Newell Cos. v. Kenney Mfg. Co.*, 864 F.2d 757, 769, 9 USPQ2d 1417, 1427 (Fed. Cir. 1988), cert. denied, 493 U.S. 814 (1989); *Richardson-Vicks, Inc., v. The Upjohn Co.*, 122 F.3d 1476, 1484, 44 USPQ2d 1181, 1187 (Fed. Cir. 1997) (showing of unexpected results and commercial success of claimed ibuprofen and psuedoephedrine combination in single tablet form, while supported by substantial evidence, held not to overcome strong prima facie case of obviousness).

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For the reasons above, it is believed that the rejections should be sustained.

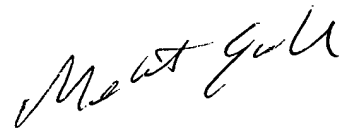
Respectfully submitted,



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November 01, 2001

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